

**REMARKS**

This is a response to the Office Action mailed on December 5, 2005. Claims 1-17 and 24-36 are pending in the application. Claims 18-23 and 36-42 have been cancelled. Claims 1-17 and 24-36 have been rejected by the Examiner. Claims 1, 15 and 24 have been amended. Claims 43-54 have been added. No new matter has been added.

The Examiner has stated on page 5 of the Office Action that because Applicant has not presented any arguments, adding hydrous silicate at various stages of the comminution process will be considered an admitted prior art. Admitted prior art is art which is in an applicant's background section in which an applicant has stated is prior art to an applicant's current invention (MPEP §2129). There is no portion of Applicants' invention that purports to set out the prior art other than Applicants' own prior patent. However, the pages cited by the Examiner on pages 5 and 6 of the Office Action (pages 4 and 5 of the Specification) are pages of the Background section which set forth the novelty of the present invention, not prior art.

***Claim Objections***

With regard to Claim 1, line 7, and Claim 24, line 7, the word further has been deleted. Please remove these objections.

Applicant has amended claims 15 and 34 to clarify the scope of the claim. Kindly remove this objection.

***Claim Rejections – 35 USC §112***

The Examiner has stated that Claim 15 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. More particularly, the Examiner states that it is not clear whether "grinding step" in

Application No. 10/649,593

line 3 as claimed is the same grinding step as claimed in the preceding claims. It is also not clear whether "a separation step" in line 5 as claimed is the same sifting step as claimed in the preceding claims. Applicants have also amended claim 34 which is similar to Claim 15. Applicants respectfully request removal of this rejection.

***Claim Rejections – 35 USC §103***

Claims 1, 10 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (U.S. 5,669,559) ("Wagner") taken in view of Prosser et al. (U.S. 3,687,699). Wagner is directed to pulverizing polyurethane in a roller mill or attrition mill with at least two rollers rotating at different circumferential speeds (See Abstract). Prosser is directed to granulating, cutting or shearing tacky material, such as chloroprene polymers. (Col. 2., lines 24-26.

The Examiner has stated that Applicants' invention is obvious over Wagner and Prosser. The Examiner has also stated that in response to Applicants' prior arguments, Prosser does not teach away from Wagner. Prosser merely improves Wagner in two ways. Prosser uses shearing action in order to reduce agglomeration and Prosser uses talc or hydrous silicate in order to reduce agglomeration. Applicants respectfully disagree.

With respect to amended Claim 1, the claim requires "grinding and sifting said polyurethane-containing flock." The Examiner states that Prosser improves Wagner and does not teach away from Wagner by using shearing to reduce agglomeration. However, as clearly stated in Prosser's specification, the shearing action is a cutting action not meant for grinding or attrition mills as used in Wagner (See Abstract).

In the present case, there is no motivation to combine the references. "The motivation, suggestion or teaching may come from **one of ordinary skill in the art**, or in some cases the

Application No. 10/649,593

**nature of the problem to be solved.”** *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d, 1313, 1317 (Emphasis added). In this case, there is no motivation to combine the references. One of ordinary skill in the art would readily recognize that the granulating, cutting and shearing action in Prosser is in **direct contrast to the crushing or grinding action of impact or attrition mills as stated in Prosser as the novel process** (See Column 2, lines 27). Moreover, Prosser is granulating tacky materials, such as chloroprene polymers. A chloroprene polymer is a synthetic rubber. As described throughout Applicants’ specification but specifically on page 3, lines 14-20, polyurethane-containing materials include, but are not limited to those materials such as polyurethane foams, molded polyurethanes, thermoplastic polyurethanes and carpets. **In general, those types of polyurethane-containing materials that can be ground into fine particles.** One of ordinary skill in the art would not combine these two processes as the materials are of such a different sort that **one of ordinary skill in the art would never consider placing a rubbery material in an attrition mill or consider using or looking to one process for a solution to the other process.** Thus, there would no motivation for one of ordinary skill in the art to combine these references.

Accordingly, independent Claim 1 is allowable over Wagner in view of Prosser. Claims 2-18 depend from Independent Claim 1 and should be allowable for at least the same reason. Kindly remove these rejections.

The Examiner has rejected independent Claim 24 for the above-mention reasons. With respect to amended independent Claim 24, the prior art does not teach or suggest all the claim limitations. For example, Wagner does not teach or suggest **“adding a selected amount of hydrous silicate at any time during the comminuting/pulverizing process such that the selected amount of hydrous silicate produces a polyurethane-containing material with a**

maximum particle size that is less than or equal to the selected size of a screen opening in a selected sifter.” Prosser does not cure this deficiency – namely, that the solid additive is added to produce a polyurethane containing material with a particle size that matches or nearly matches the selected size of a screen opening.

Moreover, as set forth above, the Examiner has stated that it would have been obvious to one skilled in the art to at the time the invention was made to provide Wagner with a dusting agent such as talc for pulverizing polyurethane as taught by Prosser. In the present case, there is no motivation to combine the references. “The motivation, suggestion or teaching may come from one of ordinary skill in the art, or in some cases the nature of the problem to be solved.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d, 1313, 1317. In this case, there is no motivation to combine the references. First, one of ordinary skill in the art would readily recognize that the granulating, cutting and shearing action in Prosser is in direct contrast to the crushing or grinding action of impact or attrition mills as stated as the novel process in Prosser (See Column 2, lines 27). Second, Prosser is granulating tacky materials, such as chloroprene polymers. Chloroprene polymer is a synthetic rubber. While as described throughout Applicants’ specification but specifically on page 3, lines 14-20, polyurethane-containing materials include, but are not limited to those materials such as polyurethane foams, shoe soles, molded polyurethanes, thermoplastic polyurethanes and carpets. **In general, those types of polyurethane-containing materials that can be ground into fine particles.** One of ordinary skill in the art would not combine these two processes as the materials are of such a different sort that one of ordinary skill in the art would never consider placing a rubbery material in an attrition mill. Thus, there would no motivation for one of ordinary skill in the art to combine these references.

Express Mail No. EV 687 138 752 US

Attorney Docket No. 85639.7

Application No. 10/649,593

Accordingly, independent Claim 24 is allowable over Wagner in view of Prosser. Claims 25-36 depend from Independent Claim 24 and should be allowable for at least the same reason. Kindly remove these rejections.

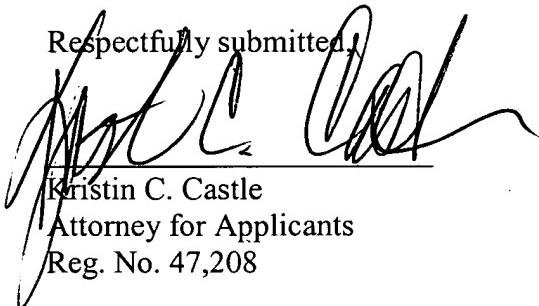
### CONCLUSION

Withdrawal of the present rejections and allowance of the claims is respectfully requested.

The Commissioner is authorized to charge any deficiencies or other amounts due to Deposit Account No. 07-1850. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 954-0235.

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Attorney Docket No. 85639.7

Application No. 10/649,593

**IN THE DRAWINGS**

Please replace the drawing of Figure 1 that was filed with the application on August 27, 2003 with the attached replacement sheet. No changes have been made and no new matter has been added to the drawing.